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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,671	04/24/2000	Michael Stephen Austin	99-0138	7622

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EXAMINER

BAXTER, JESSICA R

ART UNIT PAPER NUMBER

3731

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No. 09/556,671	Applicant(s) AUSTIN, MICHAEL STEPHEN	
	Examiner Jessica R Baxter	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/24/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>g</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Claims 39 and 40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Drawings

2. The corrected or substitute drawings were received on February 24, 2003. These drawings are acceptable.

Specification

3. The disclosure was objected to because of minor informalities. Correction is noted and the objection is withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1 and 23 recite the limitation "wherein the biocompatible material is distributed substantially equally along the length of the segment of curvature on the inside of the curvature and on the outside of the curvature." This limitation does not appear to be in the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-6 and 15 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Correction is noted and the rejection is withdrawn.

8. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 1 and 23 recite the limitation wherein the biocompatible material is distributed substantially equally along the length of the segment of curvature on the inside of the curvature and on the outside of the curvature." It is unclear what is meant by this limitation.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 8-16, 21, 23-32, 37, and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,994,071 to MacGregor.

Regarding claims 1, 8, 9, 23, 24, and 25, MacGregor discloses a prosthesis comprising a hollow tubular body comprising at least one segment of curvature (see FIGS 2A-3D and Column 2 lines 32-49).

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Regarding claim 2, MacGregor discloses that the body segment is curved in at least one plane (see FIGS 2A-3D).

Regarding claims 10-15 and 26-31, MacGregor discloses that the hollow tubular body comprises undulating wire (see FIG. 1 loops 12) formed from a shape memory alloy, a super elastic alloy, a polymer, or nitinol (see Column 5 lines 39-51).

Regarding claims 16 and 32, MacGregor discloses that the wire is uniformly displaced along the length of the body (see FIG. 1 loops 12 and lattice 16).

Regarding claims 21 and 37, MacGregor discloses that at least one branch of the prosthesis extends away from the body of the prosthesis (see FIG. 1 lattices 20 and 22).

Regarding claim 38, MacGregor discloses a medical implant comprising at least one segment of curvature (see FIGS. 2A – 3D).

12. Claims 1-9, 17, 21, 23-25, 33 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/09585 to Caro et al.

Regarding claim 1, 8, 9, and 23-25, Caro discloses a prosthesis comprising a hollow tubular body comprising at least one segment of curvature (see FIG. 5 tubing 1).

Regarding claim 2, Caro discloses that the body segment is curved in at least one plane (see FIG. 5 tubing 1).

Regarding claim 3, Caro discloses that the body segment is curved in at least two planes (see Page 5 line 33 – Page 6 line 1).

Regarding claim 4, Caro discloses that the body segment has at least two segments of curvature located in successive progression along the body and are curved in the same plane (see Page 4 lines 5-27).

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Regarding claim 5, Caro discloses that the body has at least two segments of curvature located in successive progression and curved within different planes (see Page 4 lines 5-27).

Regarding claim 6, Caro discloses that the body has at least two segments of curvature that overlap at least a portion of one another and are curved in different planes of curvature (see Page 4 lines 5-27).

Regarding claim 7, Caro discloses segments of curvature that overlap and segments of curvature that do not overlap (see Page 4 lines 5-27).

Regarding claims 17 and 33, Caro discloses that the hollow tubular body comprises a thin-walled tubular material (see page 4 lines 12-19).

Regarding claims 21 and 37, Caro discloses that the prosthesis comprises a branch that extends away from the body of the prosthesis (see FIG. 2A).

13. Claims 1, 2, 4, 8, 9, 10, 18, 19, 21-26, 34, 35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,653,743 to Martin.

Regarding claim 1, 8, 9, and 23-25, Martin discloses a prosthesis comprising a hollow tubular body with at least one segment of curvature (see FIG. 5).

Regarding claim 2, Martin discloses that the body segment is curved in at least one plane (see FIG. 5 prosthesis 1).

Regarding claim 4, Martin discloses that the body has at least two segments of curvature located in successive progression and are curved within the same plane of curvature (see FIG. 5 prosthesis 1).

Regarding claims 10 and 26, Martin discloses that the body comprises wire (see Column 2 lines 49-60).

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Regarding claims 18 and 34, Martin discloses at least one taper along the length of the body (see FIG. 1 prosthesis 1).

Regarding claims 19 and 35, Martin discloses at least one aperture on the body between the proximal end and the distal end (see FIG. 1 opening 7).

Regarding claims 21 and 37, Martin discloses that at least one branch of the prosthesis extends away from the body of the prosthesis (see FIG. 5 graft 18).

Regarding claim 22, Martin discloses that at least a portion of the prosthesis is covered with a graft covering (see Column 2 lines 49-63).

14. Claims 1, 20, 23, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,156,619 to Ehrenfield.

Ehrenfield discloses a prosthesis comprising a hollow tubular body comprising at least one segment of curvature (see FIG. 4 and Column 2 lines 36-39) and at least one non-circular cross-section along the length of the body (see FIG. 4 flange 33).

15. Claims 1, 20, 23, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,695,517 to Marin et al.

Marin discloses a prosthesis comprising a hollow tubular body comprising at least one segment of curvature (see FIG. 3 graft 46 L) and at least one non-circular cross-section along the length of the body (see Column 3 lines 24-33).

Response to Arguments

16. Applicant's arguments filed February 24, 2003 have been fully considered but they are not persuasive.

Applicant argues that the prior art does not disclose a biocompatible material with a substantially equal distribution on the inside and the outside of the segment of curvature. It is

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unclear how these references do not meet this claimed limitation. These arguments are not understood. Applicant doesn't present any actual arguments only insists that the prior art does not disclose this limitation.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Jessica R Baxter
Examiner
Art Unit 3731

jrb
jrb

June 18, 2003


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700